

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

JUN 09 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS R. HAYNES

Appeal No. 2005-1268
Application No. 10/044,728

ON BRIEF

Before KRASS, JERRY SMITH and SAADAT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 3, 5-11, and 13-18.

The invention is directed to changing the appearance of a pointer (e.g., a cursor on a monitor screen) based on the rate of movement of a pointing device (e.g., a mouse). The appearance of the pointer is automatically changed based on user defined thresholds and the rate of movement of the pointing device, permitting a quicker observation of the pointer as it moves across the screen.

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Representative independent claim 1 is reproduced as follows:

1. A method in a data processing system for changing a pointer, the method comprising:

receiving a user input indicating that a pointing device was moved;

calculating a rate of movement for the pointing device;

comparing the rate of movement with a given threshold of speed;
and

automatically updating a presentation of the pointer based on the given threshold of speed in response to receiving the user input, wherein a presentation of the pointer is altered if the rate of movement exceeds the given threshold of speed and wherein the presentation of the pointer is a series of different changes in presentation based on the rate of movement for the pointing device.

The examiner relies on the following references:

Heath et al. (Heath) 4,760,386 Jul. 26, 1988

Shinichiro¹ JP 102 07441 Aug. 07, 1998

Claims 1, 6, 8-11, 15, and 16 stand rejected under 35 U.S.C. §102 (b) as anticipated by Shinichiro.

Claims 3, 5, 7, 13, 14, 17, and 18 stand rejected under 35 U.S.C. §103. As evidence of obviousness, the examiner offers Shinichiro with regard to claims 3, 5, and 7, adding Heath with regard to claims 13, 14, 17, and 18.

¹Our understanding of the Shinichiro reference is derived from an English translation thereof, of record in this file, of which appellant has a copy (page 2 of the reply brief indicates that appellant has received a copy of the translation).

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Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

With regard to instant claim 1, the examiner points to the abstract of Shinichiro for a disclosure of the entire claimed subject matter.

Appellant does not dispute that Shinichiro discloses a method for changing a pointer whereby a user input indicates that a pointer was moved, and whereby a rate of movement is calculated for the pointing device. It is also clear that Shinichiro compares this rate of movement with a given threshold of speed (abstract of Shinichiro or page 4, lines 6-8, of the translation). Moreover, Shinichiro updates a presentation of the pointer based on the given threshold of speed in response to the user input, wherein the presentation of the pointer is altered if the rate of movement exceeds the given threshold (see page 4, paragraph 0019, of the translation, where it is indicated that when the threshold is exceeded the display size of the cursor, or the use of a

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complementary color of the background, expanding the brightness difference around the cursor, occurs).

But claim 1 also calls for the presentation of the pointer being “a series of different changes in presentation based on the rate of the movement for the pointing device.”

Appellant argues that Shinichiro does not teach this limitation. From our review of the Shinichiro translation, it does appear that the reference discloses only one threshold and one change in the appearance of the cursor when that single threshold is exceeded. Shinichiro does not teach “a series of different changes in presentation...,” as claimed. The examiner has not convinced us that Shinichiro discloses this claimed subject matter because the examiner’s response to appellant’s argument is merely to point to paragraphs 0024-0026, “where there are multiple threshold rates of speed to determine changes in the cursor display. These features of Shinichiro is [sic] the same as automatically updating a presentation of the pointer using a series of different changes in presentation based on the rate of movement or rates of movement as disclosed by the applicant” (answer-page 6). Reference to the paragraphs cited by the examiner indicates no such teaching of a “series of different changes in presentation.”

Accordingly, since we find no teaching in Shinichiro of the claimed “series of different changes in presentation,” we will not sustain the rejection of claim 1, or of claims 6, and 8-10, dependent thereon, under 35 U.S.C. §102 (b).

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Similarly, we will not sustain the rejection of claims 11, 15, and 16 under 35 U.S.C. §102 (b) because these claims contain a similar limitation.

We enter the following NEW GROUND OF REJECTION, in accordance with 37 CFR 41.50(b), against claims 1, 5-10, 13, 15, and 17.

Claims 1, 5-10, 13, 15, and 17 are rejected under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter regarded by applicant as his invention.

Each of independent claims 1, 13, 15, and 17 recites a single threshold of speed and then goes on to recite “a series of different changes in presentation...” In accordance with our understanding of the invention, as disclosed, e.g., page 11 of the specification, there can only be “a series of different changes in presentation...” if there are multiple thresholds. A single threshold can only result in a single change of presentation, as in Shinichiro. Since these claims recite only a single threshold, such a single threshold cannot support the further recitation of “a series of different changes in presentation...” Both of these recitations appearing in a single claim fail to particularly point out and distinctly claim the disclosed invention.

With regard to independent claims 11 and 16, these claims also stand rejected under 35 U.S.C. §102 (b), but these claims include the limitation of “multiple thresholds.” So, while we will also not sustain the rejection of these claims under

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35 U.S.C. §102 (b) because Shinichiro does not disclose multiple thresholds, or "a series of different changes," as claimed, claims 11 and 16 are not subject to the new ground of rejection because these claims contain the "multiple thresholds" limitation to support the recitation of "a series of different changes."

With regard to the prior art rejections of claims 5 and 7 under 35 U.S.C. §103 over Shinichiro, and of claims 13 and 17 under 35 U.S.C. §103 over Shinichiro in view of Heath, we note that we are in a quandary as to what the invention defined by the claims actually involves, as explained supra. Accordingly, we cannot resolve the issues of obviousness with any degree of certainty and will, therefore, reverse the 35 U.S.C. 103 rejection of these claims. Cf. In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962).

With regard to the rejection of claim 3, this claim is not subject to our new ground of rejection under 35 U.S.C. §112, second paragraph, because the added limitation of "other thresholds" cures the deficiency, noted supra, of claim 1. However, we will sustain the rejection of claim 3 under 35 U.S.C. §103 over Shinichiro. We find that Shinichiro clearly discloses a single threshold which, when exceeded, will change the pointer, e.g., the display size of the cursor may be expanded. We also find that Shinichiro mentions other suitable modes of changing the pointer, or cursor, such as expanding the brightness difference, or changing the complimentary color of the

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background color. Accordingly, since Shinichiro teaches changing a pointer when a certain threshold of speed is exceeded, and also teaches various changes which a cursor might undergo, it would have been obvious to the artisan that more than a single threshold may be used for changing the appearance of the cursor in more than one way, depending on the particular threshold exceeded. We find nothing unobvious about appellant's use of multiple thresholds, rather than Shinichiro's single threshold, for making more than the single change in pointer appearance taught by Shinichiro.

Thus, we sustain the rejection of claim 3 under 35 U.S.C. §103.

Finally, with regard to the rejection of claims 14 and 18 under 35 U.S.C. §103, we will sustain the rejection of these claims because while these claims contain the "multiple thresholds" limitation, and Shinichiro does not explicitly teach this limitation, we find it would have been obvious, for the reasons supra, to adapt Shinichiro's teaching of a single threshold and a single change in appearance of a pointer to the situation of multiple thresholds and multiple (or a "series of") changes in appearance of the pointer.

Claim 14 further recites certain data processing structure, such as a bus, communication unit, memory and a processing unit, while claim 18 further recites first, second and third instructions in a computer program product. The examiner relies on Heath to supply these teachings.

Appellant argues that Heath is not combinable with Shinichiro because the former is directed to a system wherein a keyboard controlled cursor and a pointer controlled by a pointing device can coexist on a visual display device, while the latter is directed to altering a cursor display based on a rate of movement of a mouse so that the cursor is easier to view. Appellant also argues that Heath does not teach the problem addressed by the present invention, but teaches away since the pointer is temporarily removed from the display.

We disagree. Shinichiro teaches the basic claimed invention and the problem addressed thereby. The examiner only used Heath to show that such typical data processing structure, or instructions, was known to be used in data processing systems where cursors are controlled. Heath was not employed for its specific control of the mouse pointer. That control is taught by Shinichiro.

Appellant argues, at pages 7-8, of the principal brief, that Shinichiro does not teach that the pointer returns to its previous appearance when the rate movement for the pointing device decreases below the given threshold of speed.

Shinichiro clearly suggests, at paragraphs 0027 and 0028 of the translation, that when a speed threshold is not exceeded, the cursor will be as “usual.” This is indicative of the cursor appearance returning to normal, or “usual” when the threshold is not exceeded. For a single threshold, this is exactly as taught by appellant. Where

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there are multiple thresholds, we find that Shinichiro's teaching of returning the cursor appearance to normal when below a certain single threshold, would have been suggestive to artisans that where there are multiple thresholds, as the speed falls below each particular threshold, the cursor, or pointer, appearance will change back to the appearance it had between particular thresholds.

While we have not sustained the rejection of claims rejected under 35 U.S.C. §102 (b) because of a lack of a specific teaching of multiple thresholds or "a series of different changes in presentation" by Shinichiro, if prosecution is continued, the examiner may wish to consider a rejection of these claims under 35 U.S.C. §103.

CONCLUSION

We have reversed the rejection of claims 1, 6, 8-11, 15, and 16 under 35 U.S.C. §102 (b). We have also reversed the rejection of claims 5, 7, 13 and 17 under 35 U.S.C. §103. We have sustained the rejection of claims 3, 14 and 18 under 35 U.S.C. 103.

Additionally, we have entered a new ground of rejection, in accordance with 37 CFR 41.50 (b), of claims 1, 5-10, 13, 15 and 17, under 35 U.S.C. §112, second paragraph.

In addition to affirming the examiner's rejection(s) of one or more claims, this opinion contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office

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21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmation is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

AFFIRMED-IN-PART
37 CFR 41.50(b)

Errol A. Krass
ERROL A. KRASS)
Administrative Patent Judge)

Jerry Smith
JERRY SMITH)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS
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